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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/934,841      | 08/23/2001  | Dennis Thomas Gilham | 5058                | 5479             |

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SILVER SPRING, MD 20910

EXAMINER

SHERR, CRISTINA O

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3621

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/934,841

Applicant(s)

GILHAM, DENNIS THOMAS

Examiner

Cristina Owen Sherr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This communication is in response to applicant's amendment filed August 21, 2006. Claims 11-13 remain pending in this case.

### ***Response to Arguments***

2. Applicant's arguments filed August 21, 2006 have been fully considered but they are not persuasive.
3. Applicant's sole argument is that the cited prior art (Windel et al, US 5,671,146), although disclosing modification of a DES key, does not disclose said modification in the context of modifying the key for each mail item as in the instant application. It is this examiner's position, that, given the how common key modification is in the field (see, e.g., the references listed but not cited in the last office action), it would be obvious to perform key modification at any stage deemed convenient for the prevention of fraud and therefore for obtaining security.
4. Further, keys may be modified based on any obvious information, including postage value, related to postage charges. Motivation for this is having the proper person or entity paid whatever money is due to them.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara et al (US 6,249,777), in view of Windel et al (US 5,671,146).

7. Regarding claim 11 –

Kara discloses a method of printing postal indicia on a plurality of mail items, said postal indicia including postage data and an authentication code, including the steps of storing a secret key; determining a period of time in which postal indicia are to be printed on a plurality of mail items (fig 2, see user password); storing a postage value relating to postage charges dispensed in said period of time (see, e.g. fig 3, 304); providing postage data including said postage value (see, e.g. fig 3, 305); generating a key relating specifically to a mail item by utilizing said secret key and said postage data; generating an authentication code by utilizing said key and said postage data; and printing said postage data and said authentication code as a postal indicium on said mail item (e.g. col 4 ln 5-40).

8. Kara does not, however, disclose a modified key or generating a modified key or modifying a key, in the context of postal security. Windel, however, does, at, e.g. column 19, ln 1-5. It would be obvious to one of ordinary skill in the art to combine the teachings of Kara and Windel in order to obtain greater security and greater fraud prevention in mail processing.

9. Regarding claim 12 –

Kara discloses a postage meter apparatus for printing postal indicia on a plurality of mail items, said postal indicia including postage data and an authentication code, including:

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clock means operative to determine a period of time in which postal indicia are to be printed on a plurality of mail items (e.g. col 8 ln 2-15, any array of memories); a register for storing a postage value relating to postage charges dispensed in said period of time; memory means for storing a secret key; electronic control means; and input means operable to input item data relating to a mail item to said electronic control means; wherein said electronic control means is configured to generate a key relating specifically to said mail item by utilizing said secret key and postage data including said item data and said postage value, and generate an authentication code by utilizing said key and said postage data (e.g. col 4 ln 5-40; e.g. col 8 ln 2-15, any array of memories).

10. As above, Kara does not, however, disclose a modified key or generating a modified key or modifying a key, in the context of postal security. Windel, however, does, at, e.g. column 19, ln 1-5. It would be obvious to one of ordinary skill in the art to combine the teachings of Kara and Windel in order to obtain greater security and greater fraud prevention in mail processing.

11. Regarding claim 13 –

Kara discloses postage meter apparatus as claimed in claim 12, including: a further register for storing a value of credit; and wherein said postage data includes said value of credit (e.g. col 8 ln 2-15, any array of memories; fig. 3, valid funding).

12. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied, to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are

applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Sansone et al (US 4,998,204) discloses a mailing system and method for low volume mailers printing postage information upon inserts.

15. Pagel et al (US 6,889,214) discloses a virtual security device.

16. Leon (US 6,424,954) discloses a postage metering system.

17. Sudia (US 5,799,086) discloses an enhanced cryptographic system and method with key escrow feature, including key modification.

18. Gelfer et al (US 6,587,843) disclose a method for improving the security of postage meter machines in the transfer of credit, including key modification.

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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